

REMARKS

Claims 5, 6, 10-13, 18-20, 73, 74, 85, 88-93, 98-100, 103-110 and 114-119 are presently pending. Claims 22-69, 71-72, 75-84, 86, 87 and 101-102 have been canceled without prejudice. Claims 5, 13, 118 and 119, have been amended to particularly point out and distinctly claim the invention. No new matter has been added. Applicants fully reserve their right to prosecute the subject matter of any canceled claim, any amended claim or any other unclaimed subject matter in one or more continuation, continuation-in-part or divisional applications.

Applicants gratefully acknowledge the Examiner's indication that the subject matter of claims 6, 10-12, 89-92, 106-109 and 117 is allowed over the art of record.

I. The Rejections Under 35 U.S.C. § 102(a)

Claim 118 has been rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Boehm *et al.*, *J. Med. Chem.* 43(14):2664-2674 (2000) ("Boehm"). In particular, the Examiner cites the compound of CA Registry No. 293758-67-5 (*i.e.*, 5-nitro-3-phenyl-1H-indazole).

Claim 118 has been amended to no longer recite 5-nitro-3-phenyl-1H-indazole. Thus, amended claim 118 does not embrace any compound of Boehm and the rejection under 35 U.S.C. § 102(a) should be withdrawn.

Claim 119 has been rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Chemical Abstracts No. 122:314528 (1995) ("Andronati Abstract"); Chemical Abstracts No. 107:198159 (1987) ("Fujimura II Abstract"); and Chemical Abstracts No. 84:31053 (1976) ("Fujimura I Abstract"). In particular, the Examiner cites the compound of CA Registry No. 576614-16-1 (*i.e.*, 5-methyl-3-phenyl-1H-indazole) as being disclosed in each reference, thus giving rise to the rejection.

Claim 119 has been amended to no longer recite 5-methyl-3-phenyl-1H-indazole. Thus, amended claim 119 does not embrace any compound of the Andronati Abstract, the Fujimura II Abstract or the Fujimura I Abstract and the rejection is now moot.

Thus, in view of these amendments, it is believed that the rejections of claims 118 and 119 under 35 U.S.C. § 102(a) have been overcome and must be withdrawn.¹

¹ Applicants' amendments should not be construed as an admission that Boehm, Andronati, Fujimura I or Fujimura II are prior art under 35 U.S.C. § 102(a) or that they are enabled. Applicants are simply expediting prosecution of the allowable subject matter.

II. The Rejections Under 35 U.S.C. §102(e)

Claims 13 and 93 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Publication No. 2002/0161022 A1 by Reich *et al.* (“Reich”). In particular, the Examiner cites compounds 84 and 85 of Reich.

Compounds 84 and 85 of Reich are those wherein R_2 is $-(CH_2)_bNR_5R_6$ and b is 0. Claim 13 has been amended to no longer recite that b can be 0. Claim 93 recites a composition comprising a compound of claim 13 and a pharmaceutically acceptable carrier. Accordingly, neither amended claim 13 or claim 93 encompass a compound of Reich.

Thus, in view of the above amendment, it is believed that the rejection of claims 13 and 93 under 35 U.S.C. § 102(e) has been overcome and must be withdrawn.

III. The Rejection Under 35 U.S.C. §103(a)

Claims 5, 13, 18-20, 71-74, 85, 88, 93, 98-105, 114-116, 118 and 119 have been rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Reich.

Claims 5 and 13 have been amended to no longer recite compounds wherein b can be 0. Thus, neither of amended claims 5 or 13 encompass any compound of Reich. Furthermore, there is no suggestion or motivation found in Reich to modify the compounds therein to arrive at the compounds of amended claim 5 or 13. Such suggestion or motivation is required in order to support a *prima facie* case of obviousness. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

The Federal Circuit has expressly required that “there must be adequate support in the prior art for the ... change in structure, in order to complete the PTO’s *prima facie* case [of obviousness] and shift the burden of going forward to the applicant.” *In re Grabiak*, 769 F.2d 729, 732 (Fed. Cir. 1985). Thus, in view of *Grabiak*, for a compound that differs from the prior art by at least one atom to be obvious, the Examiner must provide a secondary reference that teaches the interchangeability of such at least one atom of the claimed compound with the corresponding atom of the prior art.

Accordingly, absent any secondary reference suggesting the interchangeability of the functional groups of the presently claimed compounds of amended claim 5 or 13 with those disclosed in Reich, a *prima facie* case of obviousness is unsupported and cannot stand.

Applicants respectfully submit that claims 18-20, 73, 74 and 85 recite classes of compounds which are not obvious in view of Reich. In particular, these claims recite compounds wherein R_2 can be *inter alia* substituted or unsubstituted triazole, tetrazole or

indazole. It is well established that the fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. *In re Jones*, 958 F.2d 347, 350 (Fed. Cir. 1992). Furthermore, the Federal Circuit has held that the disclosure of a chemical genus does not render obvious any compound falling within the genus, particularly when the disclosure indicates a preference leading away from the claimed compounds. *In re Baird*, 16 F.3d 380, 382-383 (Fed. Cir. 1994).

Applicants respectfully submit that the compounds of claims 18-20, 73, 74 and 85 (*i.e.*, those wherein R₂ can be *inter alia* substituted or unsubstituted triazole, tetrazole or indazole) would not be obvious in view of the disclosure of Reich and that the disclosure of Reich, in fact, leads one away from the compounds of claims 18-20, 74 and 85. In particular, although, as pointed out by the Examiner, Reich broadly defines aryl and heteroaryl groups to include, among many others, triazole, tetrazole and imidazole, none of triazole, tetrazole or imidazole are set forth as examples of preferred groups for R₂ and R'₂ (*See* Reich, page 6, ¶ [0054] where preferred groups for R₁ and R'₁ are set forth which include triazole and preferred groups for R₂ and R'₂ are set forth which *do not* include triazole, tetrazole or imidazole).

When determining whether one of ordinary skill in the art would have been motivated to select particular species or a particular subgenus, the Examiner should consider *inter alia* the teachings of structural similarity (*i.e.*, which species or subgenus are described as typical, preferred or optimum). *See* MPEP 2144.08. In doing so, any teaching or suggestion of a *preferred* species or subgenus that is structurally different from the claimed species or subgenus may weigh against selecting the claimed species or subgenus and, accordingly, against a determination of obviousness. *In re Baird*, 16 F.3d at 382-383; MPEP 2144.08. Applicants respectfully submit that the absence of triazole, tetrazole and imidazole from the preferred groups set forth for R₂ and R'₂, particularly in view of the fact that triazole is set forth as a preferred group for R₁ and R'₁, rebuts or, in the least, weighs heavily against a determination that the presently claimed compounds are obvious over Reich.

Claims 88, 93, 98-100, and 103-105 relate to pharmaceutical compositions comprising a compound of the claim from which each depends (*i.e.*, claims 5, 13, 18-20, 73, 74 and 85, respectively) and a pharmaceutically acceptable carrier. In view of the amendments and remarks above with respect to the claims from which these claims depend,

Applicants believe that the rejection of claims 88, 93, 98-100, and 103-105 under 35 U.S.C. § 103(a) has been overcome.

Claims 114-116 recite specific compounds which fall within the class of compounds recited in claims 18-20, respectively, and independent claim 119 recites compounds which do not fall within a currently claimed class. For the same reasons set forth above in connection with claims 18-20, Applicants respectfully submit that the specific compounds recited in claims 114-116 and 119 are not obvious in view of Reich. In particular, as discussed above, the fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. *In re Jones*, 958 F.2d at 350. The prior art reference disclosing the generic formula must also provide the requisite motivation to make the modifications necessary to arrive at the claimed compounds. *In re Lahu*, 747 F.2d 703, 705 (Fed. Cir. 1984). As discussed above, when addressing the issue of the motivation in a prior art reference to make a certain species or subgenus, any teaching of a preferred species or subgenus by the reference which is structurally different than the claimed compounds should be considered and weighs against a determination of obviousness. MPEP 2144.08.

Independent claim 118 recites compounds which do not fall within the class of compounds disclosed by Reich. Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness because there has been no showing of a motivation to modify the compounds of Reich to arrive at the compounds of claim 118. As discussed above, in view of *Grabiak*, for a compound that differs from the prior art by at least one atom to be obvious, the Examiner must provide a secondary reference that teaches the interchangeability of such at least one atom of the claimed compound with the corresponding atom of the prior art.

Accordingly, absent any secondary reference suggesting the interchangeability of the functional groups of the presently claimed compounds of claim 118 with those disclosed in Reich, a *prima facie* case of obviousness is unsupported and cannot stand.

Claims 71-73, 102 and 103 have been canceled without prejudice.

Thus, in view of the above, it is believed that the rejection of claims 5, 13, 18-20, 73, 74, 85, 88, 93, 98-100, 103-105, 114-116, 118 and 119 (claims 71-72, 101 and 102 having been canceled without prejudice) under 35 U.S.C. § 103(a) has been overcome and must be withdrawn.

Conclusion

Applicants respectfully request that the present amendments be entered and the present remarks be made of record in the file history of the present application. An early allowance of the application is earnestly requested. The Examiner is invited to call the undersigned with any questions concerning the foregoing.

Applicants believe that the only fees due are those for the extension of time (3 months) and the Notice of Appeal; however, in the event any additional fee is required, please charge the required fee to Pennie and Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,

Anthony M. Insogna, Reg. No. 35,203

Date: January 30, 2004

By: *Michael J. Bruner, Reg. No. 47,458* 35,203
Anthony M. Insogna (Reg. No.)

JONES DAY

222 East 41st Street

New York, New York 10017

(212) 326-3939